UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,212	01/25/2001	Anoop Gupta	MS1-673US	7356

45979 7590 06/23/2005

PERKINS COLE LLP/MSFT
P. O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER	
DENNISON, JERRY B	

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/771,212	GUPTA ET AL.	
	Examiner	Art Unit	
	J. Bret Dennison	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 45-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 45-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to Amendment (RCE) of Application Number 09/771,212 received on 11 April 2005.

2. Claims 1-13 and 45-48 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 6 recites the new limitation, "the electronic mail client application displays the creator as the sender and an indication that the electronic mail message is a collaborative mail message". It is unclear to Examiner if the limitation means displaying the creator as the sender AND displaying the creator as an indication that the electronic mail message is a collaborative mail message.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. (U.S. Patent Number 6,496,849) in view of Liu et al. (U.S. Patent Number 6,769,012).

Regarding claims 1 and 6, Hansen discloses one or more computer-readable media having stored thereon a plurality of instructions that, when executed by one or more processors of a computer, causes the one or more processors to perform acts including:

receiving collaborative electronic mail messages targeting one or more recipients (Hansen, col. 3, line 65 through col. 4, line 5), each collaborative electronic message having an author (Hansen, col. 8, lines 35-40, Hansen teaches including the creating participant's name and corresponding email address), each collaborative electronic mail message including a feedback portion in which the one or more recipients can each add comments (Hansen, col. 3, line 65 through col. 4, line 7, and col. 4, lines 35-55, Hansen teaches a collaborative electronic mail messaging system where dynamic content can be changed or updated by participants in the group, allowing participants to add comments);

indicating, to a computing device corresponding to one or more of the recipients, the receipt of a new collaborative electronic mail message and its author wherein an electronic mail system of the computing device displays indication of the collaborative electronic mail message(Hansen, col. 5, lines 44-50);

Hansen also discloses participants including any specific or general computer system that is equipped to receive or read e-mail messages using standard e-mail

protocols such as the MIME or SMTP electronic mail protocol (Hansen, col. 3, lines 15-20), the computer system therefore running a client email application.

However, Hansen does not explicitly state indicating the receipt of a new collaboration electronic mail message wherein the indication includes the name of the author in a list of electronic mail messages that includes names of senders and

indicating, to the computing device, a modification to the collaborative electronic mail message resulting from a comment being added to the feedback portion, wherein the electronic mail system of the computing device updates the displayed indication of the new collaborative electronic mail message that includes the name of the author to indicate that it has been modified, without displaying another indication of the new collaborative electronic mail message

In an analogous art of networking, Liu discloses a method for managing message transactions between a senders and recipients that includes indicating a modification to a collaborative electronic mail message resulting from users responding to the original message (Fig. 3, 24) wherein the author is displayed for each modification, including the original author (Fig. 3, 14) without displaying another indication of the new collaborative electronic mail message in the list of electronic mail messages (Liu, Fig. 3, 14, col. 2, lines 60-67, Lu disclosed a pointer identifying the message at an address for the virtual mailbox).

Liu is analogous to Hansen because Liu provides a way to eliminate the need for each party to maintain duplicate information (Liu, col. 3, lines 34-36). Users can retrieve and view all correspondence at once (Liu, col. 6, lines 40-45 and Fig. 5, 22).

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate indicating the author and a modification to a collaborative electronic mail to provide a way to eliminate the need for each party to maintain duplicate information (Liu, col. 3, lines 34-36).

5. Regarding claim 2, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 1, including wherein the plurality of instructions further cause the one or more processors to perform acts including identifying, to the computing device, the size of each collaborative electronic mail message, the size of a collaborative electronic mail message including all of the content of the collaborative electronic mail message (Hansen, col. 6, lines 33-55, Hansen teaches identifying message specific information, which includes message sizes).

6. Regarding claim 3, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 1, including wherein the new collaborative electronic mail message includes an identifier of a location at an application server where the content of the new collaborative electronic mail message is stored (Hansen, col. 6, lines 33-55, Hansen teaches using a database to store all message information, and databases require identifiers for location of the information on the server).

7. Regarding claim 4, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 1, including wherein the plurality of instructions further cause the one or more processors to perform acts including:

receiving, from one of the one or more recipients, a reply to the new to collaborative electronic mail message (Hansen, col. 4, lines 45-50); and

communicating the reply to one or more electronic mail servers associated with recipients of the new collaborative electronic mail message (Hansen, col. 4, lines 1-10).

8. Regarding claim 5, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 1, including wherein the plurality of instructions further cause the one or more processors to perform acts including:

receiving, from one of the one or more recipients, a reply to the new collaborative electronic mail message (Hansen, col. 2, lines 25-50, Hansen teaches users being able to reply to messages);

communicating the reply to an electronic mail server from which the new collaborative electronic mail message was received (Hansen, col. 6, lines 33-55, Hansen teaches the users sending their replies to the server); and

receiving, from the electronic mail server, a modified collaborative electronic mail message that incorporates the reply (Hansen, col. 4, lines 10-25, Hansen teaches when the user accesses the server, the user receives the updated content).

9. Regarding claim 13, Hansen discloses a system comprising:

a first electronic mail server to receive a collaborative mail message (Hansen, col. 3 lines 10-20);

a second electronic mail server communicatively coupled to the first electronic mail server (Hansen, col. 7, lines 27-63);

an application server, communicatively coupled to the first electronic mail server, to store the content of the new collaborative mail message (Hansen, col. 7, lines 5-15); and

wherein the first electronic mail server is further configured to forward an electronic mail message including an identifier of the content of the new collaborative mail message, as stored on the application server, to the second electronic mail server (Hansen, col. 7, lines 27-63).

However, Hansen does not explicitly state wherein the electronic mail message identifies the creator of the collaborative mail message as the sender of the electronic mail message by specifying the creator in a "from" attribute of the electronic mail message.

In an analogous art of networking, Liu discloses a method for managing message transactions between a senders and recipients that includes indicating a modification to a collaborative electronic mail message resulting from users responding to the original message (Fig. 3, 24) wherein the creator is identified for the collaborative electronic mail message (Fig. 3, 14).

Liu is analogous to Hansen because Liu provides a way to eliminate the need for each party to maintain duplicate information (Liu, col. 3, lines 34-36). Users can retrieve and view all correspondence at once (Liu, col. 6, lines 40-45 and Fig. 5, 22).

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate indicating the author and a modification to a collaborative electronic mail to provide a way to eliminate the need for each party to maintain duplicate information (Liu, col. 3, lines 34-36).

10. Regarding claim 7, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 6, further comprising:

receiving a reply to the new collaborative mail message (Hansen, col. 12, lines 10-14);

modifying the new collaborative mail message in accordance with the reply(Hansen, col. 12, lines 14-17); and

sending another message to each of the one or more recipients, wherein the message includes an identifier of the modified collaborative mail message at the application server and wherein the message identifies the creator as the sender of the notification (Hansen, col. 4, lines 10-27, Hansen teaches when the users access the server, the server sends the updated message).

11. Regarding claim 8, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 7, including wherein the identifier of the new collaborative

mail message and the identifier of the modified collaborative mail message are the same identifier (Hansen, col. 5, lines 10-25, Hansen teaches users being able to modify their own message).

12. Regarding claim 9, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 6, including wherein the identifier comprises a uniform resource locator (URL) (Hansen, col. 7, lines 10-15).

13. Regarding claim 10 Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 6, including wherein the sending comprises sending the message to one or more mail servers associated with the one or more recipients (Hansen, col. 9, lines 5-11).

14. Regarding claim 11, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 6, including wherein the method is implemented

15. in an electronic mail server (Hansen, Figure 2, 20, and 22).

16. Regarding claim 12, Hansen and Liu disclose the limitations, substantially as claimed, as described in claims 6, including one or more computer-readable memories containing a computer program that is executable by a processor to perform the method recited in claim 6 (Hansen, col. 6, line 65 through col. 7, line 67).

17. Regarding claim 45, Hansen discloses a computer-readable medium having stored thereon a data structure, the data structure for storing a conventional or collaborative electronic mail message, comprising:

An indication that the data structure for storing a conventional or collaborative electronic mail message (Hansen, col. 3 lines 10-20);

a distribution list field that identifies the recipients of the collaborative electronic mail message (Hansen, col. 6, line 23-50);

a content field that includes all of the content of the collaborative electronic mail message, wherein replies to the collaborative electronic mail message alter the content in the content field (Hansen, col. 6, line 23-50);

However, Hansen does not explicitly state having a "from" field that identifies an author of the content in the content field.

In an analogous art of networking, Liu discloses including a "from" field wherein the creator is identified for the collaborative electronic mail message (Fig. 3, 14).

Liu is analogous to Hansen because Liu provides a way to eliminate the need for each party to maintain duplicate information (Liu, col. 3, lines 34-36). Users can retrieve and view all correspondence at once (Liu, col. 6, lines 40-45 and Fig. 5, 22).

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate indicating the author and a modification to a collaborative electronic mail to provide a way to eliminate the need for each party to maintain duplicate information (Liu, col. 3, lines 34-36).

18. Regarding claim 46, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 45, including wherein the data structure further comprises a root identifier that identifies an initial collaborative electronic mail message corresponding to the collaborative electronic mail message (Hansen, col. 6, line 23-50).

19. Regarding claim 47, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 45, including a parent identifier that identifies a parent collaborative electronic mail message corresponding to the collaborative electronic mail message (Hansen, col. 6, line 23-50).

20. Regarding claim 48, Hansen and Liu disclose the limitations, substantially as claimed, as described in claim 45, including a message identifier that identifies the collaborative electronic mail message (Hansen, col. 6, line 23-50).

Response to Amendment

Applicant's arguments and amendments filed on 11 April 2005 have been carefully considered but they are not deemed fully persuasive.

Applicant's arguments with respect to claims 1-5 have been fully considered but they are not persuasive. Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of identifying "that a collaborative message that is modified by a recipient is identified by an email client application as from the author" [see Applicant's Response, page 7]. It is evident from the mappings found in the above rejection that the combination of Hansen and Liu disclosed the teaching of that a

collaborative message that is modified by a recipient is identified by an email client application as from the author. Hansen disclosed participants including any specific or general computer system that is equipped to receive or read e-mail messages using standard e-mail protocols such as the MIME or SMTP electronic mail protocol (Hansen, col. 3, lines 15-20), the computer system therefore running a client email application. Liu discloses a method for managing message transactions between a senders and recipients that includes indicating a modification to a collaborative electronic mail message resulting from users responding to the original message (Fig. 3, 24) wherein the author is displayed for each modification, including the original author (Fig. 3, 14) without displaying another indication of the new collaborative electronic mail message in the list of electronic mail messages (Liu, Fig. 3, 14, col. 2, lines 60-67). Client email applications that obtain email information from an email server are well known in the art, as already shown by Hansen. As discussed above, Liu disclosed a virtual mailbox on a email server for indicating collaboration emails. Therefore it would have been obvious for the email client applications as taught in Hansen to download the email information from the email server of Liu.

Further, it is clear from the numerous teachings (previously and currently cited) that the provision for using "displaying indications of modified electronic mail and providing the author of an email" was widely implemented in the networking art.

Even though Hansen does not explicitly state providing the author of the original message, Hansen does include retrieving the author and email address of the original message when the zaplet is created. Applicant argues that "the "from" column would

identify the server, rather than the creator" [see Applicant's Response, filed 2 November 2004, page 8 of 9]. However, Simple Mail Transfer Protocol (SMTP) allows the originator of the email (in this case the server) to set the "sender" field of an outgoing email. Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention for the server to use the obtained author's email address to send the newly created zaplet to all participants. A practical example of this would be the use of web mail. A user supplies their information and the mail server sends the email.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. B. D.
Patent Examiner
Art Unit 2143

BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER